

ELECTION

Applicant elects, with traverse, what the Examiner has characterized as “Invention I,” deemed drawn to “a welding stud,” and corresponding to claims 1-17 and 25-29.

REMARKS

The Examiner has identified two ‘inventions’ in the pending claims. The Examiner’s classification of the ‘inventions’ include Group I consisting of claims 1-17 and 25-29 drawn to a welding stud and classified by the Examiner in class 411, and Group II consisting of claims 18-24 drawn to a method of manufacturing and classified by the Examiner in class 470.

The Examiner related Inventions I and II as process of making and product made. *Office Action, May 15, 2007, p. 2*. A product made and a process for making the product can be shown to be distinct inventions if the product "can be made by another and materially different process..." or if “the process as claimed is not an obvious process of making the product and the process as claimed can be used to make another materially different product.” *MPEP §806.05(f)*.

In making the restriction, the Examiner stated that the product of Invention I can be made by another and materially different process other than that set forth in Invention II because “the product can be made from casting instead of stamping or etching.” *Office Action, supra at 2*. Applicant respectfully disagrees. That is, Applicant believes that the Examiner has failed to show that the product as claimed in Invention I can be made by another materially different process.

As called for in Invention I, a welding stud comprises a body having a first and second end, the first end to engage a stud welding gun and the second end being a weld end. The process of Invention II calls for providing a welding stud having a first end and a second end, forming the first end to engage a stud welder, and forming the second end to be entirely welded to a workpiece and with increased resistance to current flow through the second end in the area between a perimeter and a central area of the second end as compared to a welding stud having a nipple and a generally planar surface thereabout. Absent from Invention II, however, is any requirement that the welding stud called for therein be formed by etching or stamping, as the Examiner has asserted. Invention II, as called for in claim 18, does not set forth a limitation as to the exact method for forming the welding stud. As such, the process of Invention II would cover stamping, etching, and casting processes.

The Examiner has thus failed to show that the product of Invention I can be made from a materially different process than that of Invention II. That is, the Examiner has failed to show

that the process of Invention II requires etching or stamping to form the welding stud of Invention I, and that the process of Invention II could not also cover a casting process.

The Examiner also stated that “the process [of Invention II] can be used for making products other than a weld stud, such as a set-screw.” *Office Action, supra at 2*. Applicant respectfully disagrees. That is, Applicant believes that the Examiner has failed to show that “the process as claimed can be used to make another materially different product” as set forth in MPEP §806.05(f).

The Examiner’s assertion that the process of Invention II can be used to make other products, “such as a set screw,” *Office Action, supra at 2*, fails to show that Invention II can be used to make another materially different product. Invention II calls for the steps of providing a welding stud, forming the first end to engage a stud welder, and forming the second end to be entirely welded to a workpiece and with increased resistance to current flow. As Invention II specifically calls for the steps of providing and forming a welding stud, it is unclear how these steps can be used to make another materially different product, such as a set screw. Thus, the Examiner’s assertion fails to show that “Invention II” can be used to make another materially different product.

As such, for at least these reasons, the Examiner has failed to show that Inventions I and II are distinct. Therefore, a restriction under MPEP 806.05(f) between Inventions I and II has not been shown, and rejoinder of Inventions I and II is required.

The Examiner is invited to call the undersigned to discuss this Election or any other matters regarding this application to further prosecution.

Respectfully submitted,

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